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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

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Applicant	:	David G. Bird
Serial No.	:	08/862,039
Filed	:	May 22, 1997
For	:	LOCATION OF MISSING VEHICLES
Group Art Unit	:	3662
Examiner	:	Gregory C. Issing

For reissue of Original Patent
No. 5,418,537, issued May 23, 1995

Appeal No. : 2002-0393

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I hereby certify that this paper is being deposited this date with the U.S. Postal Service as first class mail in an envelope addressed to: Mail Stop Appeal Brief – Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

William E. Pelton — July 23, 2007
William E. Pelton — Date
Reg. No. 25,702

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REPLY TO SUPPLEMENTAL EXAMINER'S ANSWER OF MAY 24, 2007

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

On November 20, 2006, the Board of Patent Appeals and Interferences remanded the application to the examiner to consider the following issue, and to take appropriate action:

"Was the prosecution history as a whole examined in determining whether reissue recapture applies?"

On page 4, the Board further asked, "...do the [C-I-P] '580 Patent claims that ultimately issued include the allegedly surrendered subject matter, and if not, how does this impact the alleged surrender?"

On May 24, 2007, the examiner issued a Supplemental Examiner's Answer. This paper advises: "The prosecution history as a whole has been considered in the instant reissue application 08/862,039, filed 5/22/1997, including the prosecution histories of (1) parent application 07/978,272, filed 11/18/92, issued as Patent number 5,418,537 on 5/23/95, and (2) related, continuation-in-part application 08/396,977, filed 3/1/1995, issued as Patent number 5,777,580 on 7/7/1998."

The Supplemental Examiner's Answer discusses differences between the claims allowed in "the related C-I-P patent" (i.e., No. 5,777,580, issued on application 08/396,977, which was copending with the present reissue application) and the reissue claims. The examiner concludes: "In view of the difference in scope of the claims of the parent and C-I-P applications [i.e., applications 07/978,272 and 08/396,977], the Patent claims of [C-I-P Patent] 5,777,580 do not impact the surrendered subject matter of the parent application with respect to the improper recapture or broadened claimed subject matter of the claims in the reissue application."

Appellant's Comments

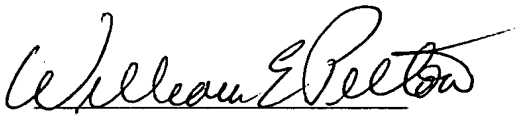
1. The Appellant agrees with the examiner's conclusion that the Patent claims of 5,777,580 do not impact the issues raised by Appellant in this appeal from a rejection of the claims in the reissue application. The Board should therefore base its decision on the papers previously submitted.

2. On page 2 of the Remand, citing In re Clement, 131 F.3d 1464, 1469, 45 USPQ2d 1161, 1164 (Fed. Cir. 1997), the Board correctly notes, "...the recapture rule

does not apply in the absence of evidence that the amendment was an admission that the scope of the [canceled or amended] claim was not patentable." This of course does not mean that even if there is evidence that the amendment was an admission that the scope of the canceled or amended claim was not patentable, then the recapture rule does apply. If there were such evidence the recapture rule would apply only to an identical or wholly encompassing (i.e., dominant) claim submitted in a reissue application. But that evidence would not support a recapture-based rejection of a reissue claim narrower in a material respect than the canceled or amended claim in the original application.

In this reissue application, each claim is either carried over without amendment from the original patent or narrower than the allegedly surrendered subject matter in a material respect. Since there is no recapture, the rejection should be reversed and the application allowed. Whittaker Corporation, Technibilt Division v. UNR Industries, Inc., 911 F.2d 709 (Fed.Cir. 1990).

Respectfully submitted,



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